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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,320	06/15/2001	Andrew Carver	5490-000216	8429

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER
PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/882,320	Applicant(s) CARVER ET AL.
	Examiner Pedro Philogene	Art Unit 3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 December 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rushdy et al (6,319,284) in view of Berman (6,017,366).

With respect to claims 1, 15, 29, 30 Rushdy et al disclose a device (10) for insertion into a first phalange (22) and a second phalange (24) so as to join the first phalange to the second phalange, comprising a substantially elongate member (16,18,20), wherein the member (16,18,20) has a first end portion (16), a middle portion (20), and second end portion (18) spaced and opposed from the first end portion, wherein the middle portion has a curvature; as set forth in column 2, lines 57-67, such that an angle is formed between the first end portion and the second end portion; as set forth in column 2, lines 57-67; wherein the first end portion and the second end portion has a surface portion for facilitating retention within the first phalange and the second phalange, as best seen in FIGS.; wherein the angle is substantially anatomically correct; as set forth in column 5, lines 12-45.

Although, Rushdy et al teach that the implant could be made of a number of materials; it is noted that Rushdy et al did not teach of a resorbable material; as claimed by applicant. However, in a similar art, Berman evidences the use of a resorbable

material in an implant to prevent impingement of the bone ends and provide tissue infiltration into the space occupied by the implant.

Therefore, given the teaching of Berman, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the implant of Rushdy et al with resorbable material as taught by Berman to prevent impingement of the bone ends and provide tissue infiltration into the space occupied by the implant.

As to the elongated member, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the implant in one piece, since it has been held that forming in one piece an article which was formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

With respect to claims 2,3,4,6,8,10,12-14,16-18,21,24,25 the above combination of references teach all the limitations, as set forth in columns 1 - 7, lines 1-68 of Rushdy/Berman; and as best seen in FIGS..

With respect to claims 26-28, the method steps, as set forth, would have been obviously carried out in the operation of the device, as set forth above.

Claims 5,7,19,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rushdy et al (6,319,284) in view of Berman (6,017,366) in view of Bramlet (5,984,970).

With respect to claims 5,7,19,20, it is noted that the above combination of references did not teach of a threaded surface, as claimed by applicant. However, in a

similar art, Bramlet evidences the use of a joint device with threaded surface to threadably secure the device to the bone substance of the respective bone.

Therefore, given the teaching of Bramlet, it would have been obvious to one having ordinary skill in the art at the time the invention to incorporate thread on the surface of the first end portion to threadably secure the device to the bone substance of the respective bone.

Claims 9,11,22,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rushdy et al (6,319,284) in view of Berman (6,017,366) in view of Saffar (5,047,059).

With respect to claims 9,11,22,23, it is noted that the above combination of references did not teach of a surface portion selected from the group consisting of shoulders, ribs, helixes or a combination thereof, as claimed by applicant. However, in a similar art, Saffar evidences the use of a joint device consisting of such a surfaces to facilitate implantation in the canal of the bones.

Therefore, given the teaching of Saffar, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the design of the device of Saffar in the device of Rushdy/Berman to facilitate implantation in the canal of the bones.

Response to Amendment

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of this new rejection.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 305-3591 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Pedro Philogene
February 4, 2003

Pedro Philogene
PEDRO PHILOGENE
PRIMARY EXAMINER